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RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036				KIM, ANDREW		
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIDEAKI IMURA and SHINGO OMOMO

Appeal 2009-004960
Application 10/697,041
Technology Center 3700

Decided: May 14, 2010

Before JEAN R. HOMERE, ST. JOHN COURTENAY III, and
CAROLYN D. THOMAS *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's rejection of claims 1-12. We have jurisdiction under 35 U.S.C. § 6(b). We reverse. We also enter a new ground of rejection against claim 8 under the provisions of 37 C.F.R. § 41.50(b).

STATEMENT OF THE CASE

INVENTION

The invention on appeal relates generally to a gaming machine including a liquid crystal display. (Spec. 1).

ILLUSTRATIVE CLAIM

1. A gaming machine comprising:

a variable display device configured to variably display a plurality of symbol rows each having a symbol placement face formed in a curved surface on which a plurality of symbols are placed;

an image display device being provided in front of and opposed to the variable display device and configured to display the symbols through a flat symbol transmission face and to display an image concerning a game;

a symbol illumination device configured to illuminate the symbols; and

an image display assistance device being provided lateral to an area between the variable display device and the image display device to cover an area sandwiched between the symbol placement face and the symbol transmission face, and configured to assist image display of the image display device.

PRIOR ART

The Examiner relies upon the following references as evidence:

Ozaki	US 2001/0031658 A1	Oct. 18, 2001
Mizukai	JP 2001 161950	

THE REJECTIONS

1. The Examiner rejected claims 1-3, and 5-12 under 35 U.S.C. § 103(a) as unpatentable by Mizukai.
2. The Examiner rejected claim 4 under 35 U.S.C. § 103(a) as unpatentable over Mizukai and Ozaki.

ISSUE

Based upon our review of the administrative record, we have determined that the following issue is dispositive in this appeal:

Under 35 U.S.C. § 103, did the Examiner err in finding that Mizukai would have taught or suggested “an image display assistance device being provided lateral to an area between the variable display device and the image display device?” (Claim 1)

PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

Invention or discovery is the requirement which constitutes the foundation of the right to obtain a patent . . . unless more ingenuity and skill were required in making or applying the said improvement than are possessed by an ordinary mechanic acquainted with the business, there is an absence of that degree of skill and ingenuity which constitute the essential elements of every invention.

Dunbar v. Myers, 94 U.S. 187, 197 (1876) (citing *Hotchkiss v. Greenwood*, 52 U.S. 248, 267 (1850)) (*Hotchkiss v. Greenwood* was cited with approval by the Supreme Court in *KSR*, 550 U.S. at 406, 415, 427).

FINDINGS OF FACT

1. Mizukai discloses a reflector (57) that indirectly illuminates the background of the drum (37). The diffused light is irradiated towards the backside and illuminates the large field on the background of the display. (Para. [0021]; Fig. 8)

ANALYSIS

We decide the question of whether the Examiner erred in determining that Mizukai would have taught or suggested “an image display assistance device being provided lateral to an area between the variable display device and the image display device,” as recited in claim 1.

The Examiner contends that it would have been obvious to modify Mizukai with laterally placed reflecting plates to assist in illuminating the area between the symbol face and the image display device. (Ans. 4).

We disagree. We do not find that the Examiner's stated position is supported in the record before us. As noted above, Mizukai discloses a reflector that illuminates the area *behind the drum*. (FF 1). Thus, we find the Examiner's position that it would have been obvious to place the reflector plate in the area between the symbols, (Ans. 4) to be conclusory. Moreover, we find the Examiner's interpretation of the "lateral to an area" limitation (see Ans. 6) to be overly broad in the context of the claim considered as a whole: i.e., "lateral to an area *between the variable display device and the image display device.*" We further note that independent claims 8 and 10 recite commensurate limitations.

Based on the record before us, we find that the Examiner erred in rejecting independent claims 1, 8, and 10. Accordingly, we reverse the Examiner's § 103 rejection of independent claims 1, 8, and 10. Because we have reversed the Examiner's rejection of each independent claim on appeal, we also reverse the Examiner's rejections of the dependent claims.

CONCLUSION

Based on the findings of facts and analysis above:

We find that under §103 the Examiner erred in determining that Mizukai would have taught or suggested "an image display assistance device being provided lateral to an area between the variable display device and the image display device." (Claim 1; *see* commensurate limitations claims 8 and 10).

NEW GROUNDS OF REJECTION

Using our authority under 37 C.F.R. § 41.50(b), we reject exemplary independent claim 8 under 35 U.S.C. § 102(b). Our rejection relies on different reasoning than that set forth by the Examiner. Due to our new reasoning, we designate our Decision as a new ground of rejection.

35 U.S.C. § 102

We find that Mizukai discloses or describes a gaming machine comprising:

a variable display device (pattern adjustable display M) configured to variably display a plurality of symbol rows on which a plurality of symbols are placed. (Para. 0012, Fig. 3, item M).

an image display device (visual display 14) being provided in front of the variable display device and configured to display an image concerning a game (Para. 0012, Fig. 2, Fig. 8) and;

a side illumination device (base 35) being provided lateral to an area between the variable display device M and the image display device 14 and configured to illuminate the symbols from a side of the symbols. (Para. [0020], ll. 1-4, Fig. 4).

Therefore, we find that Mizukai discloses or describes all of the limitations of independent claim 8 under § 102(b).

The Board of Patent Appeals and Interferences is a review body, rather than a place of initial examination. We have made a rejection above under 37 C.F.R. § 41.50(b) based on the applied prior art reference. However, we have not reviewed the remaining claims to the extent

necessary to determine whether these claims are unpatentable over the applied prior art reference and other patents cited in the record. We leave it to the instant Examiner to determine the appropriateness of any further rejections based on this reference. *See MPEP § 1213.02.*

DECISION

We reverse the Examiner's rejection of claims 1-12 under 35 U.S.C. § 103(a).

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." 37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

ORDER

REVERSED
37 C.F.R. § 41.50(b)

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